

**McDermott
Will & Emery****RECEIVED
CENTRAL FAX CENTER
OCT 11 2006**Boston Brussels Chicago Düsseldorf London Los Angeles Miami Milan
Munich New York Orange County Rome San Diego Silicon Valley Washington, D.C.

Certification of Facsimile Transmission
I hereby certify that this paper is being facsimile
transmitted to the Patent and Trademark Office
on the date shown below.
Ramyar Farid
Type or print name of person signing certification
Signature *[Signature]* Date *10/11/06*

FACSIMILE**Date:** October 11, 2006**Time Sent:**

To:	Company:	Facsimile No:	Telephone No:
Examiner Thiem D. Phan	U.S. Patent and Trademark Office	571-273-8300	
From:	Ramyar M. Farid	Direct Phone:	202.756.8146
E-Mail:	rfarid@mwe.com	Direct Fax:	202.756.8087
Sent By:	Matilda Mason	Direct Phone:	202-756-8661
Client/Matter/Tkpr:	43888-112	Original to Follow by Mail:	No
		Number of Pages, Including Cover:	
Re:	Application No.: 09/889,167		
	Attorney Docket No.: 43888-112		

Message:

This Notice of Appeal (\$500) and Pre-Appeal Brief Request for Review and Remarks is being filed in response to the Office Action dated July 11, 2006.

The information contained in this facsimile message is legally privileged and confidential information intended only for the use of the individual or entity named above. If the reader of this message is not the intended recipient, you are hereby notified that any dissemination, distribution, or copy of this facsimile is strictly prohibited. If you have received this facsimile in error, please notify us immediately by telephone and return the original message to us at the below address by mail. Thank you.

IF YOU DO NOT RECEIVE ALL OF THE PAGES, PLEASE CALL MATILDA NEWMAN AT 202-756-8661 AS SOON AS POSSIBLE.

Main Facsimile: 202.756.8087 Facsimile Operator: 202.756.8090

U.S. practice conducted through McDermott Will & Emery LLP.
600 Thirteenth Street, N.W. Washington, D.C. 20005-3096

Telephone: 202.756.8000

RECEIVED
CENTRAL FAX CENTER

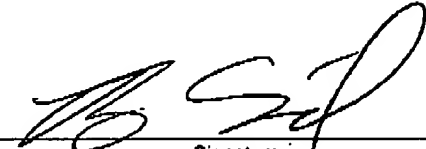
002/009

OCT 11 2006

Doc Code: AP.PRE.REQ

Based on PTO/SB/33 (07-05)
 Approved for use through xx/xx/200x. OMB 0851-00xx
 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 043888-0112	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]		Application Number 09/889,167	Filed July 11, 2001
on _____ Signature _____ Typed or Printed Name _____		First Named Inventor Kenichiro SUETSUGU, et al.	Examiner Thiem D. Phan
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input type="checkbox"/> attorney or agent of record. Registration number _____ <input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 46,692		 Signature Ramyar Farid Typed or printed name 202-756-8146 Telephone number October 11, 2006 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			

☒ Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

REMARKS

The withdrawal of the rejection of claim 14 under 35 U.S.C. § 112, second paragraph is acknowledged and appreciated.

Claims 6, 8, 14 and 21 stand rejected under 35 U.S.C. § 103 as being unpatentable over JP '834 in view of Nakatsuka et al ("Nakatsuka"). This rejection is respectfully traversed for the following reasons.

A. Neither JP '834 nor Nakatsuka, alone or in combination, disclose or suggest IC carrying claimed identification information

The Examiner relies on paragraph [0020] of JP '834 as allegedly disclosing an IC carrying the claimed identification information (i.e., information indicating presence of lead, type/composition of solder, kind of soldered parts, and material of article; see page 20, line 7 – page 21, line 17 of Applicants' specification for exemplary advantages that can be made possible by use of an IC over, for example, a bar code as used in JP '834 (e.g., increased storage, etc.); and page 21, lines 18-22 corresponding to Figures 12-13 of Applicants' drawings for a description of exemplary embodiments of the IC arrangement).

However, it is respectfully submitted that the alleged IC of JP '834 does NOT provide the information recited in the pending claims, but is simply a Timer IC recording such things as the date of manufacture, etc., to know the actual usage time. The alleged IC certainly does not record the absence/presence of lead, etc., and indeed does not carry the claimed information about the solder (e.g., type and composition of solder, etc.). JP '834 merely discloses a simple bar code to indicate information regarding heavy metals, whereas the present invention can use an IC to record a much larger depth of information which can be freely and easily changed.

In response thereto, the Examiner merely alleges on page 2, last four lines of the outstanding Office Action) that JP '834 "do indeed suggest the IC carrying the identification

Error! No text of specified style in document.

information of anticipated parts that can affect the environment ... and suggest mainly of the recycling of lead from the printed circuit board.” It appears the Examiner is confusing what is recorded by the bar code of JP ‘834 with that which is stored by the Timer IC. JP ‘834 is completely silent as to the Timer *IC* recording the absence/presence of lead, etc., let alone the claimed information about the solder (e.g., type and composition of solder, etc).

B. Neither JP ‘834 nor Nakatsuka, alone or in combination, disclose or suggest identification information carrying information about the type and composition of the solder

The Examiner admits that JP ‘834 does not have identification information which carries information about the type and composition of the solder. The Examiner therefore relies on the Abstract of Nakatsuka as allegedly teaching such information. The Examiner’s reliance on Nakatsuka is not understood.

The relied on portion of Nakatsuka is completely silent as to marking products to identify the type and/or composition of solder contained in the product. Nakatsuka merely discloses lead-free solder compositions *per se*, but does not suggest marking the product in which the disclosed solder is used to identify the type and/or composition of the solder. At best, the cited prior art may, for argument’s sake, suggest using the lead-free solder compositions taught by Nakatsuka in the products disclosed by JP ‘834; but, the cited prior art does not suggest modifying the bar codes of JP ‘834 so that they carry information about the type and/or composition of the solder. Indeed, it appears that Nakatsuka is completely silent as to identifier-markings on products, let alone suggest markings that specifically identify the type and/or composition of the solder.

The Examiner has offered no evidence *from the prior art* that discloses or suggests an article having identification information which carries information about the type and/or

Error! No text of specified style in document.

composition of the solder. Indeed, only Applicants' specification discloses such a feature and the motivation for providing it within the particular combination recited in the claims.

C. Neither JP '834 nor Nakatsuka, alone or in combination, disclose or suggest identification information indicating presence of lead when the article or housing contains lead

With respect to this issue, the Examiner asserts that Applicants' arguments filed on December 27, 2004 are "gratuitous since Sn, Bi, ... are not claimed." However, Applicants never argued that Sn, Bi, ..., are claimed elements of the present invention. Rather, Applicants are trying to illustrate to the Examiner why JP '834's bar code is not *lead* identification information. JP '834's bar code identifies heavy metal content, and the Examiner has improperly interpreted heavy metal as if it embodied only lead. This is clearly incorrect. Lead is just one type of heavy metal. Heavy metals include Sn, Bi, Au, Ag, etc.. Accordingly, when JP '834's bar code indicates that the article contains heavy metal, this does NOT necessitate that the article contains lead.

If the Examiner maintains this position, in order to clarify issues on the record for a possible appeal to the Board, the Examiner is respectfully requested to answer this question: if JP '834's bar code indicates heavy metal is contained in the article, does this mean that lead is contained in the article? It appears that the Examiner's answer to this question is "yes" in view of the Examiner's continued position that JP '834 discloses "lead identification information." Indeed, the Examiner's answer would have to be "yes" to take the position that he has taken.

In contrast, it is Applicants' position that if JP '834's bar code indicates heavy metal is contained in the article, such indication does not mean that lead *must* be contained in the article. Indeed, if JP '834's bar code indicates heavy metal is contained in the article, it is quite possible that no lead is contained in the article (e.g., heavy metal contained in article may simply be Sn,

Error! No text of specified style in document.

Bi, Au, and/or Ag, *without* lead). Accordingly, JP '834's bar code does not indicate lead information *specifically* as recited in the claims. The Examiner is reminded that "inherency may not be established by probabilities or possibilities", *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999).

D. Neither JP '834 nor Nakatsuka, alone or in combination, disclose or suggest that the housing carries the lead identification information

In addition, with respect to claim 8, the cited prior art further does not disclose or suggest that the *housing* carries the lead identification information. Rather, the bar code of JP '834 is attached on the surface of the printed board. To overcome this deficiency of JP '834, the Examiner merely alleges that it would have been obvious to have the bar code of JP '834 imprinted on the housing which accommodates the printed circuit boards or articles However, the Examiner has not provided any prior art to support this allegation. Instead, the allegation is based entirely on improper hindsight reasoning. The Examiner has offered no prior art that discloses or suggests the aforementioned feature, and simply concludes such a feature is obvious based on the Examiner's own opinion. Indeed, only Applicants' specification discloses such a feature and the motivation for providing it within the particular combination recited in the claims.

The Examiner cites *In re McLaughlin* on page 6 of the February 22, 2005 Office Action as support that hindsight is sometimes proper. However, *In re McLaughlin* is not relevant to the instant case. As set forth in MPEP § 2145(X)(A), *In re McLaughlin* suggests that some hindsight may be proper as it pertains to the rationale *for combining references*. That is, if two references disclose all of the claim limitations, then there may be instances where the rationale to combine those references to reach the claimed invention may sometimes depend on some manner of hindsight.

In re McLaughlin does not support the position that limitations which are completely missing in the prior art can nonetheless be held to be obvious. *In re McLaughlin* therefore can

Error! No text of specified style in document.

not be relied on as a substitute to prior art for alleging obviousness of a limitation not otherwise disclosed in the prior art. In the instant case, the Examiner has improperly used *In re McLaughlin* as a substitute to prior art. That is, the Examiner has not produced prior art which discloses a *housing* that carries the lead identification information, so that the holding of *In re McLaughlin* is not relevant to, and can not be relied on in, the present case.

If the Examiner maintains this rejection, pursuant to MPEP § 2144.03(C), Applicants hereby challenge the Examiner's allegation that it would have been obvious to have the lead identification information of JP '834 carried on the housing, and respectfully request documentary evidence of his findings.

Based on all the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn. Withdrawn independent claims 11 and 12 are submitted to be patentable for at least the reasons discussed above regarding claim 8. Accordingly, the Examiner is respectfully requested to reconsider the withdrawal of claims 11-13. To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,
McDERMOTT WILL & EMERY LLP


Ramyar M. Farid
Registration No. 46,692

Please recognize our Customer No. 20277 as our
correspondence address.

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 RMF:MWE
Facsimile: 202.756.8087
Date: October 11, 2006